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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,567	03/25/2004	Shoji Miura	01-583	4842

23400 7590 12/01/2005

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EXAMINER

LEWIS, MONICA

ART UNIT PAPER NUMBER

2822

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,567

Applicant(s)

MIURA ET AL.

Examiner

Monica Lewis

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30days MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This restriction is in response to the application filed March 25, 2004.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Embodiment I (Claims 1-3, 5, 6, 12 and 18), directed to a semiconductor switching element, a first and second electrode, a control electrode wherein the control electrode exposing surface of the element faces, a conductive layer, two radiating members, a mold resin, an insulating layer and a non-insulating portion;

Embodiment II (Claims 1, 4 and 13-17), directed to a semiconductor switching element, a first and second electrode, a control electrode, a conductive layer, two radiating members, a mold resin, an insulating layer, a non-insulating portion, a input portion includes a lead terminal for control signals;

Embodiment III (Claims 1, 7 and 8), directed to a semiconductor switching element, a first and second electrode, a control electrode, a conductive layer, two radiating members, a mold resin, an insulating layer wherein the non-insulating portion is formed as an opening of the insulating layer such that in an overhead view an area of the non-insulating portion surrounds an area of the first and second electrodes that is exposed on the control-electrode-exposing surface;

Embodiment IV (Claims 1 and 9), directed to a semiconductor switching element, a first and second electrode, a control electrode, a conductive layer is electrically

Art Unit: 2822

connected using a bonding wire with the control electrode element, two radiating members, a mold resin, an insulating layer and a non-insulating portion;

Embodiment V (Claims 1 and 10), directed to a semiconductor switching element, a first and second electrode, a control electrode, a conductive layer, two radiating members, a mold resin, element is one of a plurality of elements are disposed with gaps therebetween in a direction of the surfaces of the elements such that a surface of one element is not overlapped with a surface of an adjacent element, an insulating layer and a non-insulating portion; and

Embodiment VI (Claims 1 and 11), directed to a semiconductor switching element, a first and second electrode, a control electrode, a conductive layer, a control electrode element, two radiating members includes a hole member where the mold resin member can be disposed, a mold resin, an insulating layer and a non-insulating portion.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

Art Unit: 2822

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee under 37 CFR 1.17(i).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Lewis whose telephone number is 571-272-1838. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zandra Smith can be reached on 571-272-2429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular and after final

Application/Control Number: 10/808,567

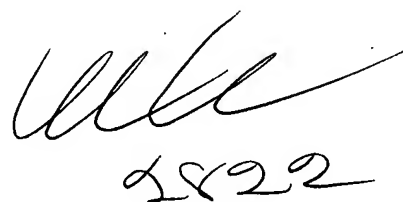
Page 5

Art Unit: 2822

communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ML

November 14, 2005

A handwritten signature in cursive script, followed by the number 2822 written in a similar cursive style.